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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,955	02/09/2004	Colleen Zielske	03211	1658
20879	7590	08/22/2006		
EMCH, SCHAFFER, SCHAUB & PORCELLO CO P O BOX 916 ONE SEAGATE SUITE 1980 TOLEDO, OH 43697			EXAMINER AHMAD, NASSER	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,955

Applicant(s)

ZIELSKE, COLLEEN

Examiner

Nasser Ahmad

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Rejections Withdrawn

1. Claims 16 and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Pemberton (6692594) made in the last Office Action of March 13, 2006 in view of the amendment of June 8, 2006.
2. Claims 17, 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Milliorn (2004/0247812) made in the last Office Action in view of the amendment.
3. Claims 1- 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milliorn in view of the English Abstract of Japanese:2001-226649 made in the last Office Action in view of the amendment.
4. Claims 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, made in the last Office Action in view of the amendment.

Response to Arguments

5. Applicant's arguments with respect to claims 1-9, 16-23 and new claims 24-26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 16 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (4965113).

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Jones relates to a first layer of adhesive (C) which is water soluble (figure-2 and col. 6, lines 10-11), a second carrier layer of plastic film (B), such as polyethylene, etc. (col. 1, lines 57-58) treated with a first release coating between the first layer and the second layer (surface 10 of the carrier layer is releasably bonded to the adhesive layer) is provided with release coating between the adhesive and the second layer. The presence of the second release coating on the opposite side (12) of the first release coating of the second layer, such that first release coating (on side 10) requires a greater force for removing said adhesive layer from the carrier layer than the force required to remove the opposite side (12) from the adhesive layer (col. 3, lines 3-9). Regarding the preamble phrase, it has not been given any patentable weight because the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description not depending for completeness upon the introductory clause.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 17, 20-23 , 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Milliorn (2004/0247812).

Milliorn relates to a roll of labels for affixing to a surface (abstract). The label comprises a first layer of water dispersible (water soluble) adhesive, a second layer (carrier) of material such as plastic, foil, etc. which are non-soluble in water, the second layer is adhered to one side of the first layer, and a first release coating is provided in contact

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with and on the other side of the first layer following the formation of a roll (paragraph-[009]).

Regarding the method of recording usage of products (claim 20), Milliorn discloses the steps of providing a label having the structure, as discussed above, including a facesheet overlying the opposite surface of the adhesive, removing the carrier release sheet, affixing the label to a container and it would inherently remove the label by applying water as the adhesive is water soluble.

The properties of the adhesive is also inherently taught by Jones because the water soluble adhesive would inherently not form a slurry or agglomeration which requires filtering-off in order to recycle the water.

Further, because the adhesive is water soluble, the dispersed adhesive particles would not be visible to the human eye.

Regarding claims 22 and 23, the label of million would provide for printing thereon.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 17-19, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Torrey (3741786).

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Jones, as discussed above, teaches a stack of the transfers. However, Jones fail to teach that the transfers are in a roll form. Torrey discloses that transfer tape can be provided in a roll form (figure-1, abstract and col. 2, lines 8-16). Therefore, because these two stacks or roll form were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute roll for the stack in the invention of Jones.

Claim 24 is taught by Jones as discussed above showing that the first release coating is stronger than the second release coating as the adhesive remains with the first release coating when it is pulled from the second release coating.

Claims 25 and 26 are also taught by Jones because the water soluble adhesive would inherently not form a slurry or agglomeration which requires filtering-off in order to recycle the water.

11. Claims 1- 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milliorn in view of the English Abstract of Japanese:2001-226649.

Milliorn, as discussed above, fails to teach the adhesive layer is a double-sided adhesive. The English Abstact of Japanese: 2001-226649 discloses a water releasable double-sided adhesive tape for adhering articles to a surface and removing it for recycling. The tape has a water-soluble adhesive provided on one side of a non-woven fabric, that may be laminated to a plastic film or a metal foil, and a self adhesive layer on the other side of the fabric. Therefore, it would have been obvious to one having ordinary skill in the art to utilize the teaching of the English Abstract of Japanese: 2001-

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226649 in the invention of Milliorn with the motivation to provide for recycling of labels by dispersing it in water .

Million's adhesive is a water soluble adhesive that would inherently not form a slurry or agglomeration which requires filtering-off in order to recycle the water.

Response to Arguments

12. Applicant's arguments filed 6/8/2006 have been fully considered but they are not persuasive.

The attorney for the Applicant acknowledges that Milliorn discloses the feature of using an adhesive which is water dispersible is noted.

Applicant also argues that the feature of the adhesive "... being of a type which, upon dispersion in water, does not form slurries or agglomerations which require filtering-off in order to recycle the water" is not shown or suggested by Milliorn or The English Abstract of Japanese 2001-226649 references. This is not deemed to be convincing because Million's adhesive water soluble and, as such, said adhesive would exhibit said feature as is **now** being claimed. Further, applicant has failed to show otherwise and mere argument without any evidence is not found to be persuasive.

Conclusion

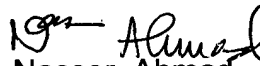
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-

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1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad 8/18/06
Primary Examiner
Art Unit 1772

N. Ahmad.
August 18, 2006.